

## REMARKS

Claims 1-21 are currently pending. Applicants respectfully request reconsideration of the present application. Newly presented claim 21 is supported inter alia at page 4, line 14 and page 11, line 3 of the original specification.

1. Claims 1-8 and 13-14 were rejected under 35 U.S.C. § 103 (a) as being unpatenable over Hunter (U.S. Patent 6,850,901). The Applicant respectfully traverses.

Hunter teaches an on-line shopping network, wherein a user is able to purchase products from a shopping network by referencing the product number. The purchasers are required to set up an account (register) and thereafter are permitted to order products from the shopping network (C 3, L 1-7). A new account is established by storing information retrieved from the purchaser in a customer database. The information includes name, billing address, customer ID verification, etc. (C 7, L 29-54). The customer ID verification can be a phone ID, voice recognition or PIN and is used by the system to verify the identification of the purchaser each time the purchaser places and order.

On the contrary, Applicant's invention does not require a purchaser to register an account to access information from the telephone shopping network. A purchaser is instantly allowed to request information simply by establishing a *temporary* password, which can be valid only for a single transaction (See, claim 21). The system is able to verify the identification of the purchaser using the temporary password and purchaser ID (telephone number of purchaser), instead of using purchaser authentication information which is registered in advance and fixed

(unless modified separately). Hunter's password is not temporary; a purchaser's established password/customer ID verification is used each time the purchaser places an order for a product.

The United States Patent and Trademark Office (PTO) asserts that Hunter teaches establishing a caller as a new customer and updating the customer record which implies the information set for a customer can change (referencing Figure 3; col. 7, lines 19-54). Regardless as to whether Hunter's customer identification information can be changed, Hunter's customer ID verification is not temporary. The customer ID verification is stored in the customer database (permanent storage) with the intent of remaining there after completion of a transaction for future use, which indicates that the customer ID verification is fixed. If, in fact, Hunter does allow for the modification of the customer ID verification, the ID is still fixed unless and/or until a modification is specifically performed. For these reasons, it is not reasonable to conclude that Hunter's customer ID verification is a temporary password.

In Hunter's system, requested product information is retrieved by the on-line shopping service during the telephone connection in which the request is made. The scope of Applicant's claims requires that the requested information is retrieved after ending the telephone conversation in which the request is made. The PTO attempts to reconcile this difference by asserting that it would have been "obvious to try", citing to KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_ (2007), to provide a caller making a product information request with the option of hanging up once the product information request is entered since the caller is able to hang up after placing an order for a product.

Firstly, *KSR International Co. v. Teleflex Inc.* provides a basis for such obviousness rejections. The PTO must articulate adequate reasoning with some rational underpinning to support a legal conclusion of obviousness. In the instant case, the PTO is required to establish (1) that there is a design need or market pressure to solve a problem and (2) there are a finite number of identified, predictable solutions and (3) that a person of ordinary skill has good reason to pursue the known options within his or her technical grasp, in order to adequately articulate reasoning to support a legal conclusion of obviousness based on an obvious to try theory. The PTO has failed to establish the aforementioned elements and thus has failed to establish a prima facie case of obviousness.

Secondly, Hunter's system allows for two options after a product order (not a product information request) has been placed, (1) hang up or (2) wait for a confirmation. In either scenario, the purchaser is ordering a product which will be shipped to the purchaser (C 7, L 22-26) and there is not a need for the purchaser to remain on the line. Hence, Hunter does not provide these options because there is a design need or market pressure to solve a problem; instead it is the logical thing to do after an order has been placed since the product will be shipped to the purchaser.

But assuming arguendo the proposed modification was supported by the record, the modification proposed by the PTO and the hypothetical result would not meet the claim recitations. In Applicant's system the purchaser is requesting information which will be retrieved and provided to the purchaser via the telephone network. Applicant's system intends for the purchaser to hang up and receive the information during a subsequent telephone connection to minimize telephone charges for telephone shopping

Hunter allows the purchaser to optionally wait for a *confirmation* of an order, this feature is not analogous to waiting for information, meeting purchasing conditions received from the purchaser, to be retrieved from the online shopping network since the shopping network essentially has to perform a search to find the requested information meeting the purchaser's conditions. Hence, it is not reasonable to conclude that since Hunter allows a purchaser to hang up after placing a product order it is obvious to allow the purchaser to hang up after placing a product information request since the two scenarios are NOT analogous. Awaiting a confirmation for a product order does not require the retrieval of requested information and thus has no delay considerations, whereas the other scenario does.

Furthermore, Hunter describes in Figure 3, the process for requesting product information. The disclosure does not indicate that the purchaser may hang up and retrieve the requested information subsequently. Thus, if Hunter intended for the hanging up feature to provide a design solution, Hunter would have incorporated this feature with the process for requesting product information.

As amended, claim 1 reestablishes a telephone connection to the user using the user's originator telephone number and confirms the user using the temporary password AFTER the original telephone connection has ended and the article information has been retrieved from by the on-line shopping service and THEREAFTER providing the article information retrieved and arranging a transaction according to the user's selection. Hunter does not teach these features.

For the aforementioned reasons, withdrawal of the rejection to independent claims 1 and 13 is respectfully requested.

Applicant respectfully submits that dependent claims 2-8, 14 and 20 are allowable for at least the same reasons discussed above with respect to independent claims 1 and 13. Moreover, these claims are further distinguishable over the applied reference by the additional elements recited therein.

2. Claims 9-12 and 15-20 were rejected under 35 U.S.C. § 103 (a) as being unpatenable over Hunter (U.S. Patent 6,850,901) in view of Whigham (US 6,584,309). The Applicant respectfully traverses.

Hunter does not teach the claimed features of claim 9 for the reasons stated above for claims 1 and 13. Additionally, Claim 9 includes the feature requesting a telephone company billing server to bill a purchase charge as a telephone charge when a transaction is arranged according to the user's selection. The PTO concedes that Hunter does not teach this feature and relies upon Whigham and *KSR v. Teleflex* to reconcile the deficiency.

The Office Action asserts that Whigham teaches a product purchasing system whereby a customer using a cellular telephone to purchase a product is billed by the product provider. The Office Action further asserts that one of ordinary skill in the art at the time the invention was made would have recognized that applying the known technique of Whigham would have yielded predictable results and resulted in an improved system and one of ordinary skill in the art would have recognized that applying the technique of Whigham to the teachings of Hunter would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems.

MPEP, Section 2143 (D) provides the following:

To reject a claim based on this rationale (Applying a Known Technique to a Known Device (Method, or Product) Ready for Improvement To Yield Predictable Results), Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);
- (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The Office Action articulates finding three above and fails to address elements 1, 2 and 4. Consistent with the MPEP 2143 (D), since all of the findings were not made, the obviousness rationale based on applying a known technique to a known device ready for improvement to yield predictable results cannot be used to support

the conclusion that claims 9-12 and 15-20 would have been obvious to one of ordinary skill in the art.

For these reasons, the Applicant respectfully requests withdrawal of the rejection to claims 9-12 and 15-20.

Applicant respectfully submits that dependent claims 10-12, 15-18 and 20 are allowable for at least the same reasons discussed above with respect to independent claims 9 and 13. Moreover, these claims are further distinguishable over the applied reference by the additional elements recited therein.

## CONCLUSION

Based on at least the foregoing amendments and remarks, the Applicant submits that claims 1-20 are allowable, and this application is in condition for allowance.

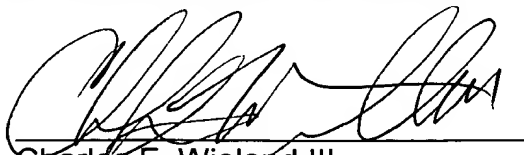
Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event the instant application can be placed in better form, Applicant requests that the undersigned attorney be contacted at the number below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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